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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,939	01/30/2004	Fumito Nariyuki	FS-F03228-01	4131

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TAIYO CORPORATION
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EXAMINER

CHEA, THORL

ART UNIT PAPER NUMBER

1752

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/766,939

Applicant(s)

NARIYUKI, FUMITO

Examiner

Thorl Chea

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is responsive to the filing of this instant application; claims 1-20 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada et al (US Patent No. 6,210,983).

Okada et al discloses a process for forming image in a photothermographic material comprising an image-wise exposing to radiation source and thermally developing the image-wised exposed material with a developing time from 1 to 180 second at the temperature 80 °C to 250 °C (column 44, lines 42-53). The photothermographic material contains an organic silver salt, a photosensitive silver halide, a reducing agent and a compound of the formula X-L₁-D wherein D is an electron donative group, X is an adsorption promoting group to silver halide, and L₁ is a valent bond or a linking group (abstract and columns 3-22). The silver halide includes silver iodide and silver iodobromide having silver iodide content 0.1 to 40 mole % (column 36, lines 3-17). The silver halide should preferably have a smaller grain size for the purpose of minimizing white turbidity after image formation, preferably 0.01 micron to 0.15 micron (column 35, lines 37-51). The preferred reducing agent is hindered phenol and bisphenols (column 38, lines 45-50 and column 39, lines 30-33). See also toning agent is disclosed in column 39, lines 40-68 to

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column 40, lines 1-20; the mecapto compound for retarding or accelerating development in column 40, lines 20-25; the ultra-high contrast agent such as hydrazine in column 42, lines 66-67 to column 43, lines 1-43; the matting agent in column 26, lines 21-67; and antifoggants including halogen-substituted organic compound in column 42, lines 27-53. Okada discloses the silver halide including silver iodide and silver iodobromide having silver iodide content from 0.1 to 40 mole % and the a compound of formula X-L₁-D. The silver iodide and silver iodide overlaps the scope of silver halide having silver iodide content of 40 mole % to 100 mole % present in the claimed invention. The scope of silver iodide in Okada et al is considered as silver halide having 100 mole % of iodide and the upper limit of silver iodide content (40 mole %) in silver iodobromide taught in Okada et al overlaps 40 mole % of the silver iodide content claimed in the present claimed invention. The compound of formula (I) and the scope of the compound presented in claim 24 are within the scope of generic formula X-L₁-D taught in Okada et al. Therefore, it would have been obvious to the worker of ordinary skill in the art at the time the invention was made to provide an image using a photothermographic material using either silver iodide or silver bromide having silver iodide from 0.1 to 40 mole % in combination with the compound of formula X-L₁-D such as suggested in Okada et al, and thereby provide a process as claimed.

4. Claims 8, 14, 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada et al (US Patent No. 6,210,983) as applied to claims 1-26 above, and further in view of Toya et al (US Patent 5,656,419). The polyhalogenate compound and the bisphenols reducing agent is taught Toya et al in column 28, claims 14-15 and the is disclosed in column 20, formula (A). it would have been obvious to the worker of ordinary skill in the art at the time the

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invention was made to use a known antifoggant and reducing agent taught Toya et al such as suggested in Okada et al, and thereby provide a process as claimed.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-26 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ohezeki et al (US 2004/0033454). See the process in on page 39, [0402] which discloses the development time in the range of 1 second to 180 second; the exposure on page 38, [0393] to [0397] to column 39, [0398]; the photothermographic material contains silver halide having iodide content from 40 % by mole to 100 % by mole in on page 3, [0055] and page 49, claims 19-20; the compound within the scope of the claimed formula (I) on pages 6, [0115] to page 19; the development accelerator on page 26, [0253] to page 29; the antifoggant on pages 31, [0300]; the toning agent on page 31, [0296] and the

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reducing agent on page 22, [0214]. Ohezeki et al discloses a process of forming an image using a material present in the claimed invention wherein the development time overlaps the time of 1 to 12 second of the claimed invention. Therefore, the process lacks novelty. Alternatively, it would have been obvious to develop a material taught Ohezeki et al within the time and temperature taught therein with an expectation of achieving a good quality image.

Response to Arguments

8. Applicant's arguments filed August 4, 2005 have been fully considered but they are not persuasive of the new ground of rejection set forth above. The Declaration under Rule 37 CFR 1.132 on August 4, 2005 fails to overcome the rejection above since it is irrelevant to Okada et al or Ohezeki et al. Moreover, "(e)vidence of secondary considerations, such as unexpected results or commercial success, is irrelevant to 35 U.S.C 102 rejections and thus cannot overcome a rejection so based. In re Wiggins, 488 F.2d 538, 543, 179 USPQ 421, 425 (CCPA 1973).

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571) 272-1328. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tchea *thc*
October 14, 2005

Thorl Chea
Thorl Chea
Primary Examiner
Art Unit 1752